

REMARKS

As a preliminary matter, Applicants acknowledge the withdrawal of the objection as to the Abstract, and of the rejections under 35 U.S.C. § 112.

Applicants are amending claim 1 to further clarify the specific structural features of the invention. This amendment is believed to address the ambiguity asserted in the Official Action by including a specific recitation, in the body of the claim, that the tubular elastic fabric structure covers the outer surface of a balloon catheter. Applicants believe that this amendment is purely formal and that it does not change the scope of the claims. Further, it is apparent that Applicants have not made this amendment for reasons related to patentability. Moreover, Applicants respectfully request that this limitation of claim 1 be given the weight that is appropriate to a specifically recited structural feature in a pending claim.

Restriction Requirement

Applicants respectfully renew their request that Restriction Requirement be withdrawn upon reconsideration. Applicants further respectfully request that claims 18 to 31 be rejoined for examination in accordance with the provisions of M.P.E.P. § 821.04.

Rejections under 35 U.S.C. § 103

The Official Action dated April 16, 2003, has repeated the rejection of claims 1 to 9, 11 to 14, and 17 as obvious over U.S. Patent No. 4,637,396 issued to Cook (hereinafter "Cook") in light of U.S. Patent No. 3,981,415 issued to Fowler *et al.* (hereinafter "Fowler"). Also repeated are the rejection of claim 10 as obvious over Cook and Fowler in view of U.S. Patent No. 5,741,325 issued to Chaikof *et al.* (hereinafter "Chaikof"), the rejection of claim 15 as obvious over Cook and Fowler in view of U.S. Patent No. 4,704,130 issued to Gilding *et al.* (hereinafter "Gilding"), and the rejection of claims 32 to 34 as obvious over Cook and Fowler in view of U.S. Patent No. 6,159,238 issued to Killion *et al.* (hereinafter "Killion"), although new

reasoning has now been adduced for the rejection of claim 33. In addition, the Official Action repeats the rejection of claim 16 under 35 U.S.C. § 103 as obvious over Cook and Fowler in view of U.S. Patent No. 4,998,421 issued to Zafiroglu (hereinafter “Zafiroglu”). Finally, the rejection of claim 35 as obvious over Cook and Fowler in view of Killion is also repeated.

These are the sole reasons presented in the Official Action dated April 16, 2003, why the present application has not been allowed. Applicants respectfully traverse these rejections. The reasoning submitted previously in the present prosecution is neither withdrawn nor abandoned. Applicants also submit the following reasoning:

First, each of the rejections under 35 U.S.C. § 103 is based on the combination of Cook and Fowler. Briefly, Applicants respectfully reiterate that the combined disclosures of Cook and Fowler do not teach or suggest every limitation of Applicants’ claimed invention. For example, Cook does not describe a balloon catheter cover, but rather a reinforcing fabric that is internal to the balloon structure. See, e.g., Cook at col. 2, ll. 38 – 43. Nor does Cook teach or suggest elastic circumferential fibers and less elastic longitudinal fibers.

Fowler has been cited to support the proposition that a fabric structure of interconnected circumferential and longitudinal yarns is known in the art. Without addressing this proposition, Applicants respectfully renew their objection to the citation of Fowler, which is drawn from a non-analogous art. Moreover, combining Cook and Fowler renders the balloon catheter in Cook unfit for its intended purpose. Therefore, there is no motivation to combine these references.

Nevertheless, even if the combination of Cook and Fowler were proper, the claimed invention, taken as a whole, is still not taught or suggested by the cited references. Cook does not teach a balloon catheter cover. It does not teach longitudinal dimensional stability to lengthening as well as shortening. It does not teach elastic circumferential fibers and less elastic longitudinal fibers. It does not teach interconnected circumferential and longitudinal yarns. There simply is no suggestion of a balloon catheter cover in Fowler. At the most, a combination of Cook and Fowler would still

require that the resulting fabric be the middle layer of a balloon structure. Therefore, the cited references, alone or in combination, do not teach or suggest every element of claim 1.

Turning to the points newly raised in the Official Action of April 16, 2004, at paragraph 9 it is stated that claim 1 recites a method of forming the tubular elastic structure, rather than a specific structural feature of the invention. Applicants respectfully take issue with this assertion. In general the phrase "formed by doing something" describes a method; in contrast, the phrase "formed of a thing" denotes structure. In this regard, Claim 1 is clear on its face, because "the tubular elastic structure is formed of interconnected circumferential and longitudinal yarns". Thus, the yarns are structural elements of which the tubular elastic structure is formed. Accordingly, Applicants respectfully request that this limitation of claim 1 be given the weight that is appropriate to a specifically recited structural feature in a pending claim.

Applicants also respectfully question the relevance of the assertion in paragraphs 9 and 16 that "there is no teaching in Cook that precludes the tubular elastic structure of Cook from covering the outer surface of a balloon catheter." It is well established that the prior art references cited to support a rejection under 35 U.S.C. § 103 must teach or suggest every claim element. The reasoning set forth in the Official Action postulates an alternative regime under which any reference that does not actually teach away from a claimed element may be said to describe or suggest it. It remains apparent, however, that neither Cook nor Fowler teaches or suggests a balloon catheter cover, as is specifically recited in claim 1.

Accordingly, Applicants respectfully request that the sole rejection of Claim 1, which is for obviousness over Cook and Fowler, be withdrawn upon reconsideration.

Claims 2 through 18 and 32 through 35 are also rejected under 35 U.S.C. § 103. Each rejection relies on Cook and Fowler in view of one or more secondary references. Each of claims 2 through 18 and 32 through 35 depends, directly or indirectly, from claim 1. Therefore, by statute, claims 2 through 18 and 32 through 35 include every element of independent claim 1.

As Applicants have set forth in detail above, the Cook and Fowler references do not teach or suggest every limitation of claim 1. It follows by logic that Cook and Fowler also do not teach or suggest every limitation of the dependent claims. For this reason, Applicants respectfully submit that the dependent claims are also not obvious. The above logic holds regardless of whether secondary references are asserted to show optional features of the invention appearing in the dependent claims.

With respect to the rejection of claim 33, the Official Action at paragraph 15 states that the variations in the strut spacing, as described in Killion, render obvious Applicants' claimed variation in the braiding yarn spacing. In response, Applicants respectfully submit that the self-expanding stents of Killion are plainly not analogous to Applicants' braided structure. Their functions are quite opposite, in fact, in that self-expanding stents exert radial force in an outward direction from inside a tubular structure, whereas Applicants' braided structure is a tubular elastic fabric structure that exerts radial force in an inward direction from outside a balloon catheter. Stated differently, Killion's stents provide internal support, and Applicants' braided structure supplies external pressure. It is well established that a rejection for obviousness cannot be based on a reference that changes the basic principle of operation of the claimed invention. See, e.g., M.P.E.P. at § 2143.01.

Furthermore, Applicants respectfully take issue with the assertion in the Official Action that varying the braiding yarn spacing is a method limitation. To the contrary, the braiding yarn spacing in itself is an entirely structural limitation. It follows by syllogism that a variation in the braiding yarn spacing is a structural variation. For example, a tubular elastic structure with uniform yarn spacing along the tube's axis is structurally distinct from a tubular elastic structure in which the yarn spacing is greater at the termini of the tube than it is at the center of the tube. Therefore, Applicants respectfully request that this limitation also be given the weight that is appropriate to a specifically recited structural feature in a pending claim.

In summary, Applicants respectfully submit that the pending claims are not obvious over Cook and Fowler and optionally in view of Chaikof, Killion, Gilding or Zafiroglu. Accordingly, Applicants respectfully

Application No. 10/084,545
Docket No. AD6799 US NA

request that the rejections of claims 1 through 18 and 32 through 35 be withdrawn upon reconsideration.

Conclusion

A Petition for an Extension of Time for two months and the required fee for the extension is filed concurrently herewith. Should any further fee be required in connection with the present amendment, the Examiner is authorized to charge such fee to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Application No. 10/084,545
Docket No. AD6799 US NA

In view of the above remarks and amendments, it is felt that all claims are in condition for allowance and such action is requested. Should the Examiner believe that an interview or other action in Applicants' behalf would expedite prosecution of the application, the Examiner is urged to contact Applicants' attorney by telephone at (302) 992-3219.

Respectfully submitted,



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